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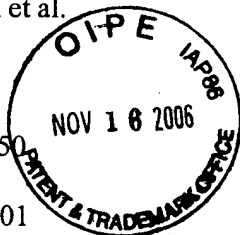
**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND**  
**INTERFERENCES**

Inventor(s): Salil Pradhan et al.

Confirmation No: 5410

Application No: 09/809,150

Filing Date: March 14, 2001



Attorney Docket No. 10005619-1

Examiner: Andrew J. Fischer

Group Art Unit: 3627

**SUBJECT: MEDIATED SHOPPING METHOD AND SYSTEM**

**APPEAL BRIEF UNDER 37 C.F.R. § 41.37**

**Mail Stop Appeal Brief – Patents**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir/Madam:

This Appeal Brief is presented in support of the Notice of Appeal filed on August 10, 2006, from the Final Rejection mailed March 10, 2006 rejecting claims 1-9, 21-23, and 28-30 of the above-identified application.

The U.S. Patent and Trademark Office is hereby authorized to charge **Deposit Account No. 08-2025** in the amount of **\$500.00** for the filing fee for an Appeal Brief.

A petition for a one month extension of time is hereby requested. A request is made to charge **Deposit Account No. 08-2025** in the amount of **\$120.00** for the one month extension of time. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 08-2025 pursuant to 37 C.F.R. 1.25. Additionally, please charge any fees required under 37 C.F.R. 1.16, 1.17, 1.19, 1.20, and 1.21 to Deposit Account 08-2025.

Appellant respectfully requests reversal of the Examiner's rejection of pending claims 1-9, 21-23, and 28-30.

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**REAL PARTY IN INTEREST**

The real party in interest is Hewlett-Packard Development Company, LP having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

**RELATED APPEALS AND INTERFERENCES**

Appellant submits that there are no related appeals or interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal.

**STATUS OF CLAIMS**

Claims 1-9, 21-23, and 28-30 are pending in the application (see Claims Appendix), and are the subject of the present Appeal.

Claims 1-9, 21-23, and 28-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Purcell (U.S. 5,940,807) in view of Bilibin et al. (U.S. 2005/0197892 A1).

Claims 1-9, 21-23, and 28-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stolfo (U.S. 2001/0044785 A1) in view of Britton et al. (U.S. 6,535,896 B2).

Claims 1-9, 21-23, and 28-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shanahan (U.S. 6,496,692) in view of Britton and Bilibin et al..

**STATUS OF AMENDMENTS**

No amendments have been entered subsequent to the Final Rejection mailed March 10, 2006. The claims listed in the Claims Appendix, therefore, reflect the claims as of March 10, 2006.

**SUMMARY OF THE CLAIMED SUBJECT MATTER**

One aspect of the present invention, as claimed in independent claim 1, provides a method for providing mediated services to a client device. An example of a context of a

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system in which such a method can operate is illustrated in Figure 1. A client device 120 has a predetermined communication protocol and a predetermined display format. (See Applicants' Specification, page 11, lines 8- 27). In Figure 1, the client device 120 communicates with a mediator 130 which provides mediated shopping services between the client 120, merchant websites (140, 144) and a shipping company 160. Examples of mediated shopping services can include but are not limited to communication protocol conversion, content adaptation, shopping cart services, payment and delivery services (See Specification, page 12 lines 1-8). For illustrative purposes, the method of claim 1 is discussed in the context of the system of claim 1. The mediator 130 receives a request for a web page from the client device 120 and sends the request to a merchant web site (140, 144). (See also Figure 7 and Specification pages 19-20. Upon receiving the requested information from the merchant web site at the mediator, the mediator 130 transforms the information into the predetermined communication protocol and predetermined display format that is suitable for the client device at the mediator, and sends the transformed information via a network to the client device from the mediator. (See Specification page 15, line 24 to page 16, line 3 and page 20, lines 1-4). The mediator provides mediated shipping services (See Specification page 14, lines 10-12 and page 19, lines 7-8) wherein providing mediated shipping services includes the client sending delivery information to the mediator, and the mediator directly providing the delivery information to a shipping company and arranging for the shipping company to pick-up the merchandise from the merchant wherein the client delivery information is not provided to the merchant (See Specification page 6, lines 16-26).

**GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Appellants seek review of the rejection of claims 1-9, 21-23, and 28-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Purcell (U.S. 5,940,807) in view of Bilibin et al. (U.S. 2005/0197892 A1).

Appellants seek review of the rejection of claims 1-9, 21-23, and 28-30 under 35 U.S.C. § 103(a) as being unpatentable over Stolfo (U.S. 2001/0044785 A1) in view of Britton et al. (U.S. 6,535,896 B2).

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Appellants seek review of the rejection of claims 1-9, 21-23, and 28-30 under 35 U.S.C. § 103(a) as being unpatentable over Shanahan (U.S. 6,496,692) in view of Britton and Bilibin et al.

**ARGUMENT**

**Rejection of Claims 1-9, 21-23 and 28-30 under 35 U.S.C. § 103(a)**

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claims 1-9, 21-23, and 28-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Purcell (U.S. 5,940,807) in view of Bilibin et al. (U.S. 2005/0197892 A1).

**Discussion of Claim 1**

The rejection of claims 1-9, 21-23 and 28-30 alleges the following:

Purcell '847 discloses a web based e-commerce site including transforming the information into a predetermined communications protocol (HTTP); transforming the information into a predetermined display format (HTML, XHML, or ASCII); and that client information is not shared with the seller.

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Purcell discloses the host may be a web site available to receive log-ins from a plurality of users. *See* column 8, lines 15-19. Purcell, however, fails to teach receiving a request for a web page from a client device and sending the request to a merchant web site.

In particular, a merchant web site is not taught by Purcell. Also, receiving a request for a web page and sending the request to a merchant web site is not taught by Purcell. Instead, a buyer may access the information management system to analyze a listing of products that may be purchased by the buyer. The information management system does not forward a request for a web page received from the buyer to a merchant web site, such that a buyer may view what products listed at the merchant web site without accessing the merchant web site. Thus, the features of claim 1 are not taught by Purcell.

The rejection alleges that Purcell discloses that client information is not shared with the seller. On the contrary, Purcell discloses that client information is shared with the seller. With respect to buy/sell transactions, Purcell discloses the host may remain an intermediary who conveys messages. *See* column 10, lines 10-22. Thus, buyer information is conveyed to the seller to conduct transactions. Furthermore, claim 1 recites providing mediated shipping services where the client delivery information is not provided to the merchant. Purcell is silent with respect to how delivery is performed. However, Purcell discloses that the host may remain an intermediary who conveys messages. Thus, Purcell discloses conveying buyer information to the seller. In Purcell, the seller could only make delivery to the buyer if the buyer provided delivery information to the seller or if the host forwarded the delivery information to the seller. Thus, Purcell fails to teach or suggest providing mediated shipping services where the client delivery information is NOT provided to the merchant. In fact, Purcell teaches away from not providing information to the merchant, because it discloses

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that either the buyer and seller deal directly with each other or the host forwards the buyer information to the seller. *See* column 10, lines 10-22.

The rejection states:

Purcell '847 does not directly disclose how the items are shipped. Bilibin however directly discloses a web-based method of selecting a shipper. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Purcell '847 to include a web-based method of selecting a shipper. Such a modification would have helped reduce shipping costs by allowing the customers to choose the shipper that is the most appropriate for them.

Bilibin fails to teach mediated shipping services where the client delivery information is NOT provided to the merchant. Bilibin discloses users providing origin and destination postal codes directly into a shipping management system (See Abstract). As noted in one embodiment, "the Shipper (also referred to as the "Seller") and the Recipient (also referred to as the "Buyer") provide information to the System to facilitate and manage a particular shipment (col. 5, para. 100 and See col. 25, paras 361). In another embodiment the Shipper/Seller provides all the information, and the Recipient/Buyer gets a tracking number to check status (Id.). In any event, the Shipper knows the destination. For example, see page 24, para. 350 in which "Seller inputs the Buyer's Name 351, the Buyer's e-mail address 352" and see also column 26, para. 372 in which the Seller can view the Shipping Log created which is described in para. 371 as "a platform with which the Shipper/Seller controls the shipping and attendant functions for all packages shipped or to be shipped by the particular Shipper/Seller." Paragraph 372 states "Each Shipping log line item contains the System tracking number 438, the addressee name 437 ..... and control buttons that allow the Seller to request details 443, instruct the system to ship the item 444, void the shipment 445, or reprint

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a label 446.” Clearly, Bilibin envisions that client delivery information is provided to the seller or merchant.

The combination of Purcell in view of Bilibin fails to disclose, teach, or suggest each of the elements of claim 1, nor motivate one of ordinary skill in the art to make or use the claimed invention.

Furthermore, the arguments with respect to claim 1 are applicable to its dependent claims 2-9, 21-23 and 28-30. If the rejection is maintained, the Examiner must provide a detailed explanation of the disclosures in Bilibin and Purcell singly or in combination that teach or suggest these features. The rejection fails to specifically address any of the steps recited in the dependent claims. It is unclear how the Examiner is interpreting Bilibin or Purcell to teach the features of the dependent claims.

Section 706 of the MPEP states that the goal of examination is to clearly articulate any rejection early in the prosecution process so that the Applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. This rejection does not clearly articulate how each and every feature of the claims are taught by Bilibin and Purcell singly or in combination. Furthermore, if the rejection is maintained, the rejection cannot be made final because the Applicants have not had a fair opportunity to respond to a rejection that articulates how Bilibin or Purcell teach each and every feature of the dependent claims.

It is respectfully requested that the Board reverse this 35 U.S.C. § 103(a) Final Rejection with respect to the pending claims.

Claims 1-9, 21-23, and 28-30 under 35 U.S.C. § 103(a) as being unpatentable over Stolfo (U.S. 2001/0044785 A1) in view of Britton et al. (U.S. 6,535,896 B2).



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According to the rejection, "Stolfo discloses the claimed invention but does not directly disclose the predetermined protocols and predetermined display format."

Stolfo fails to teach or suggest receiving a request for a web page from the client device; sending the request to a merchant web site; receiving the requested information from the merchant web site at a mediator; and sending the information via a network to the client device from the mediator. Instead, Stolfo discloses the customer browses the merchant web site directly without a mediator. *See* paragraph 28.

Stolfo also discloses a server 108 that receives a user's mailing address and encrypts the mailing address. The encrypted mailing address is transmitted to the merchant. The server 108, however, does not receive a request for a web page, send the request to a merchant web site; receive the requested information from the merchant web site at a mediator; and send the information to the client.

Stolfo discloses a method shown in figure 2 and described in paragraph 34. At step 210 the encrypted shipping information is provided to the merchant and at step 212 the encrypted shipping information is provided to a shipper.

Stolfo, however, fails to teach or suggest mediated shipping services wherein the client delivery information is not provided to the merchant. Stolfo clearly discloses encrypted shipping information is provided to the merchant. This is not the same as NOT providing client delivery information to the merchant. For purposes of anonymity, providing encrypted shipping information is not as safe as not providing the information at all because the merchant may obtain the decryption information from the supplier or otherwise decrypt the client delivery information. Also, Stolfo appears to have the merchant send the encrypted shipping information to the shipper, so the shipping of Stolfo is not mediated.

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Claim 1 also recites, “the mediator directly providing the delivery information to a shipping company and arranging for the shipping company to pick-up the merchandise from the merchant.” Stolfo fails to teach or suggest the server 108 directly providing the delivery information to a shipping company. Stolfo also fails to teach or suggest the server 108 arranging for the shipping company to pick-up the merchandise from the merchant.

Britton’s is focused on tailoring web page content in HTML by converting portions to XML for display on pervasive computing devices. It does not discuss or concern itself with shipping. Therefore, Britton’s is not making up for the deficiencies of Stolfo.

The combination of Stolfo in view of Britton fails to disclose, teach, or suggest each of the elements of claim 1, nor motivate one of ordinary skill in the art to make or use the claimed invention. Furthermore, the arguments with respect to claim 1 are applicable to its dependent claims 2-9, 21-23 and 28-30. If the rejection is maintained, the Examiner must provide a detailed explanation of the disclosures in Stolfo and Britton singly or in combination that teach or suggest these features.

It is respectfully requested that the Board reverse this 35 U.S.C. § 103(a) Final Rejection with respect to the pending claims.

Claims 1-9, 21-23, and 28-30 under 35 U.S.C. § 103(a) as being unpatentable over Shanahan (U.S. 6,496,692) in view of Britton and Bilibin et al.

The Final Office Action in paragraph 8 states “Shanahan discloses the claimed invention including purchasing products over the Internet. Shanahan does not directly disclose providing mediating shipping services. Bilibin teaches providing mediated shipping services. .... Britton is cited in the rejection simply to show *how*, in Shanahan, one of ordinary skill in the art transforms information into a predetermined protocol.

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As noted Shanahan fails to teach, suggest or disclose providing mediating shipping services. As discussed above, Bilibin fails to teach mediated shipping services where the client delivery information is NOT provided to the merchant. Britton also fails to provide a lack of disclosure, teaching or motivation of this element.

The combination of Shanahan in view of Britton and Bilibin fails to disclose, teach, or suggest each of the elements of claim 1, nor motivate one of ordinary skill in the art to make or use the claimed invention. Furthermore, the arguments with respect to claim 1 are applicable to its dependent claims 2-9, 21-23 and 28-30. If the rejection is maintained, the Examiner must provide a detailed explanation of the disclosures in Shanahan, Bilibin and Britton singly or in combination that teach or suggest these features.

It is respectfully requested that the Board reverse this 35 U.S.C. § 103(a) Final Rejection with respect to the pending claims.

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**CONCLUSION**

It is respectfully requested that the Board reverse the final rejections of claims claims 1-9, 21-23 and 28-30 under both 35 U.S.C. § 103(a).

Respectfully submitted,

Salil Pradhan et al.

*Eileen Lehmann 11/13/06*

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**CERTIFICATE UNDER 37 C.F.R. 1.8:**

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 13<sup>th</sup> day of November, 2006.

By *Eileen A. Lehmann*  
Name: Eileen A. Lehmann

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**CLAIMS APPENDIX**

1. A method for providing mediated services to a client device having a predetermined

communication protocol and a predetermined display format comprising:

(a) receiving a request for a web page from the client device;

(b) sending the request to a merchant web site;

(c) receiving the requested information from the merchant web site at a mediator;

(d) transforming the information into the predetermined communication protocol and predetermined display format that is suitable for the client device at the mediator; and

(e) sending the transformed information via a network to the client device from the mediator; and

(f) providing mediated shipping services; wherein the step of providing mediated shipping services includes

the client sending delivery information to the mediator;

the mediator directly providing the delivery information to a shipping company and arranging for the shipping company to pick-up the merchandise from the merchant;

wherein the client delivery information is not provided to the merchant.

2. The method of claim 1 further comprising:

(f) providing at least one mediated electronic commerce service for a merchant.

3. The method of claim 2 wherein the step of providing at least one electronic commerce service for the merchant includes one of shopping cart services, billing services, shipping services, and payment services.

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4. The method of claim 1 wherein the step of transforming the information into the predetermined communication protocol and predetermined display format that is suitable for the client device includes:

transforming the information into one of an HTTP communication protocol and WAP communication protocol.

5. The method of claim 1 wherein the step of transforming the information into the predetermined communication protocol and predetermined display format that is suitable for the client device includes:

transforming the information into one of a HTML display format and VML display format.

6. The method of claim 1 wherein the step of receiving the requested information from the merchant web site includes:

receiving information in one of a proprietary format, a mark-up language format, an XML format, and other format designed for exchanging information.

7. The method of claim 1 further comprising:

(f) providing mediated shopping services; wherein the step of providing mediated shopping services includes

the client device sending a request to add or delete items from a shopping cart; and

receiving the add or delete requests, and responsive thereto for updating a shopping cart record.

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8. The method of claim 1 further comprising:

(f) providing mediated payment services; wherein the step of providing mediated payment services includes

the client sending a purchase request to purchase one or more items in a shopping cart;

receiving the purchase request; and

responsive to the purchase request for updating a shopping cart record to reflect the purchase.

9. The method of claim 8 wherein the step of providing mediated payment services further includes

a client providing payment information to a mediator;

the mediator debiting a client's account; and

the mediator handling payment to a merchant;

wherein the account information of the client is not provided to the merchant.

Claims 10-20 (Canceled).

21. The method of claim 1, wherein the step of receiving a request for a web page comprises receiving a request for a web page from the client device, wherein the request includes a request for product information from the merchant web site.

22. The method of claim 1, wherein a virtual identifier of the merchant web site is determined by passively interrogating a source, the source being operable to transmit or broadcast the virtual identifier to a client device in a predetermined range.

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23. The method of claim 1, wherein a virtual identifier of the merchant web site is determined by scanning readable code.

Claims 24-27 (Canceled).

28. The method of claim 1, wherein transforming the information into the predetermined communication protocol and predetermined display format that is suitable for the client device at the mediator further comprises transforming the information into a plurality of different predetermined communication protocols and a plurality of different predetermined display formats for a plurality of clients based on a display format and a communication protocol used by each of a plurality of client devices.

29. The method of claim 28, wherein sending the transformed information via a network to the client device from the mediator further comprises sending the transformed information to the plurality of clients using the plurality of different predetermined communication protocols and the plurality of different predetermined display formats.

30. The method of claim 1, wherein receiving the requested information from the merchant web site at a mediator further comprises receiving the requested information in a generic display format from the merchant web site.



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**EVIDENCE APPENDIX**

None

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**RELATED PROCEEDINGS APPENDIX**

None